

REMARKS

In the Office Action dated January 11, 2005, the Examiner objected to the drawings under 37 CFR §§ 1.84(p)(4), 1.84(p)(5), and 1.83(a). The Examiner also objected to various informalities in the abstract, specification, and claims 1-11. The Examiner also rejected claims 1-9 and 11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,575,294 to *Perry et al* ("*Perry*"). The Examiner further rejected claims 1-6, 8, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,293,032 to *Waits*. Finally, the Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Perry*.

In this amendment, Applicants have amended claims 1-3, 7, 9, and 10 without prejudice or disclaimer. Claims 4-6, 8, and 11-55 are canceled. Moreover, Applicants have added claims 56-69. Accordingly, claims 1-3, 7, 9, 10, and 56-69 are currently pending.

Drawing Objections

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(4) because reference character 602a was allegedly used to designate both an aperture of an upper sole as shown in Fig. 6 and a depressible portion of an inner sole as shown in Fig. 8. Applicants, however, respectfully traverse this objection for the reasons set forth below.

Applicants respectfully submit that the reference numeral 602a has not been used to designate both "an aperture of an upper sole" in Figure 6 and "a depressible portion of an inner sole" in Figure 8. In fact, the reference numeral used in Figure 8 is

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawings include changes to Figures 1-3 and 11. Figures 1 and 3 have been amended to add reference numeral 900a. Also, Figure 2 has been amended to add battery 701. Lastly, Figure 11 has been amended to remove reference numeral 1001g and its associated lead line.

The Examiner is respectfully requested to approve these changes. No new matter has been added.

Attachments: Replacement Sheets for Figures 1-3 and 11

620a – not 602a. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner also objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference signs 701, 15, 607, and 1002.

In this amendment, Applicants have amended the disclosure as follows: (1) the battery and reference sign “701” as mentioned on Page 7, line 18 has been added to Fig. 2, (2) the reference sign “15” mentioned on Page 7, lines 31 and 32 has been corrected to read “151,” (3) the reference sign “607” mentioned on Page 11, line 27 has been amended to read “607g,” and (4) the reference sign “1002” mentioned on Page 15, line 14 has amended to read “1002g.” Accordingly, Applicants respectfully submit that the drawings as amended depict the reference signs noted by the Examiner and requests that the Examiner withdraw the objection.

The Examiner next objected to the drawings under 37 CFR 1.83(a) as failing to show the feature of “one or more portions of light affecting means on a wall of the chamber” as claimed in claim 10.

By this amendment, the reference sign 900a has been added to Figures 1 and 3 to show the “one or more portions of light affecting means on a wall of the chamber.” Accordingly, Applicants respectfully submit that the drawings as amended show the claimed subject matter and respectfully requests that the Examiner withdraw the objection.

Abstract Objections

The Examiner objected to the abstract for various informalities including the Abstract not being on a separate sheet. In this amendment, Applicants have provided a new abstract on a separate sheet to replace the objected-to Abstract. Accordingly, Applicants respectfully request that the Examiner withdraw the objections to the Abstract.

Specification Objections

The Examiner objected to various informalities in the disclosure. The Examiner first alleged that numeral "602" is incorrect and should be changed to "602i." However, Applicants note that the reference sign "620" used at Page 12, line 26 is consistent with Figure 8 because that figure shows the inner sole portion as referenced by the number "620."

Regarding the Examiner's objection pertaining to Page 15, line 20, the reference number "1001g" has been corrected to read "1002g" which is consistent with amended Figure 11. The references to "filaments 1002g" at Page 15, line 31 and to "filament 1002g" at Page 15, line 33 are therefore now consistent with the drawings.

The Examiner also objected to the specification as failing to provide proper antecedent basis for the control means operable to receive information defining an image as claimed in claim 7. Although Applicants respectfully disagree with this objection, in view of Applicant's amendment to claim 7 and cancellation of claim 6, the Examiner's objection is rendered moot. Accordingly, Applicants respectfully request that the Examiner withdraw the objections to the specification.

Claim Objections

The Examiner first objected to claim 6 as lacking antecedent basis for "the motive means." Because Applicants have canceled claim 6, this objection is therefore rendered moot.

The Examiner also objected to claims 1-11 for containing the phrase "such as." Applicants' amendments to the claims, however, obviate the Examiner's objection. Accordingly, Applicants respectfully request that the Examiner withdraw the objections to the claims.

Claim Rejections Under 35 U.S.C. § 102

The Rejection of Claims 1-9 and 11 Under 35 U.S.C. § 102(b) As Being Anticipated by *Perry*.

In Paragraphs 11-13 of the Office Action, the Examiner rejected claims 1-9 and 11 under 35 U.S.C. § 102(b) as being anticipated by *Perry*. For the reasons set forth below, however, Applicants respectfully request that the Examiner withdraw the rejection.

In order to properly establish that a prior art reference anticipates applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.

Cir. 1989). The cited reference, *Perry*, however, does not disclose each and every element of the claims as required by § 102.

Claim 1 as amended recites an article of apparel carrying an enclosed chamber and a light source operable to illuminate the chamber with light, the chamber having a light-affecting device adapted to affect light from the light source so as to produce a light pattern, and the chamber having a light-transmissive portion providing a window through which light from the light source can be transmitted to enable the light pattern to be viewed, the article also carrying a controller having a sensor operable to sense motion of the article of apparel resulting from motion of at least part of a wearer of the article of apparel, the controller being operable to control activation of the light source in response to motion of the article of apparel sensed by the sensor.

Applicants respectfully submit that there is no disclosure or suggestion of the subject matter of amended claim 1 in *Perry*. Rather, *Perry* describes a method and device for managing freezing gait disorders of the extrapyramidal nervous system by projecting a beam of light to provide a luminous mark in the path of the standing individual. The projection device may be used alone or adapted to an assistive support such as a cane or walker or to an item of clothing. The luminous mark is flashed at will by push button control.

Applicants further note that there is no disclosure or suggestion in *Perry* of an article of apparel as set forth in claim 1 that carries a controller having a sensor operable to sense motion of the article of apparel resulting from motion of at least part of a wearer of the article of apparel, the controller being operable to control activation of the light source in response to motion of the article of apparel sensed by the sensor.

Indeed, Applicants note that such a feature would be completely contrary to the aims of *Perry*. Thus, *Perry* is concerned with providing a mechanism for encouraging a patient who is having difficulty in walking to walk by “stepping over” a light line or luminous mark that the patient himself deliberately generates by operating a hand or foot switch. Applicants submit that there is no disclosure of suggestion in *Perry* of an item of apparel carrying a controller having a sensor operable to sense motion of the article of apparel. Indeed, where the sensor is incorporated in an item of apparel as shown in Figure 8 of *Perry*, Applicants note that it would make no sense for the *Perry* mechanism to have a sensor operable to sense motion of the item of apparel because the aim of *Perry* is to provide a luminous mark to encourage the patient to move his foot and step over the luminous mark. If activation of the light source in *Perry* was controlled in response to motion of the item of apparel, then the luminous mark would not be provided until the patient actually tried to take a step. On the other hand, *Perry* wishes to achieve the provision of a luminous mark before the patient takes a step so as to encourage the patient to step over that luminous mark.

In addition, Applicants respectfully submit that newly-added independent claims 58 and 67 include limitations that are the same or similar to limitations in claim 1 that distinguish that claim from *Perry*. Accordingly, claims 58 and 67, as well as all dependent claims thereon, are allowable.

The Rejection of Claims 1-6, 8, and 11 Under 35 U.S.C. § 102(e) as Being Anticipated by *Waits*.

In Paragraphs 14-16 of the Office Action, the Examiner rejected claims 1-6, 8, and 11 under 35 U.S.C. § 102(e) as being anticipated by *Waits*. For the reasons set

forth below, however, Applicants respectfully request that the Examiner withdraw the rejection.

Waits describes a lighted slipper comprising a slipper body having a pair of light housings mounted to the exterior surface forward of the foot opening of the slipper body. Each light housing has a planar top and a front aperture. A battery is encased in a switch housing that includes a switch for activating lights housed within the light housings. As shown in Figure 5, a hub 48 within each housing receives a shaft fixedly attached to a respective cap member or knob mounted on top of the planar surface of the housing. The other end of each shaft carries a circular support plate holding a plurality of colored lenses so that when the user rotates the knob different colored lenses can be positioned in front of the light sources.

Regarding amended claim 1, Applicants submit that there is no disclosure or suggestion in *Waits* of an article of apparel carrying a controller having a sensor operable to sense motion of the article of apparel resulting from motion of at least part of a wearer of the article of apparel, the controller being operable to control activation of a light source in response to motion of the article of apparel sensed by the sensor. Rather, in *Waits*, activation of the light sources and selection of the color filters is completely independent of any motion of the slipper. Thus, in *Waits*, the lights are activated by the user manipulating a switch 28 within the switch housing 22 (column 3, lines 53 to 55) and the color filters are selected by the user rotating the knobs 52 provided on top of the light housings (column 3, lines 55 to 58). Nothing whatsoever in *Waits* is responsive to motion of the article apparel resulting from motion of at least part of a wearer of the article of apparel. The slipper described by *Waits* will not light up

while the wearer is walking unless the wearer has previously activated the switch 28. Thus, the slipper of *Waits* is completely unresponsive to motion of the slipper resulting from motion of the wearer.

In addition, Applicants respectfully submit that newly-added independent claims 58 and 67 include limitations that are the same or similar to limitations in claim 1 that distinguish that claim from *Perry*. Accordingly, claims 58 and 67, as well as all dependent claims thereon, are allowable.

Furthermore, claims 2, 3, 7, 9, 10, 56, and 57 are dependent on claim 1 and should be allowable for the same reasons as claim 1. Also, claims 68 and 69 are dependent on claim 67 and should be allowable for the same reasons as claim 67. Moreover, claims 59-66 are dependent on claim 58 and should allowable for the same reasons as claim 58.

Claim Rejections Under 35 U.S.C. § 103

The Rejection of Claim 10 under 35 U.S.C. § 103(a) As Being Unpatentable Over *Perry*.

The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Perry*. For the reasons set forth below, however, Applicants respectfully submit that claim 10 as originally filed is not obvious over *Perry* and claim 10 is therefore patentable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

Applicant traverses the rejection because the Examiner has not established a prima facie case of obviousness. To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or

references, taken alone or combined, must teach or suggest each and every element recited in the claims. MPEP § 2143.03 (8th ed. 2001, 2d rev. May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Id. at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Id. at § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” Id. at § 2143.

However, because claim 10 is dependent upon claim 1, it is allowable at least for the same reasons as claim 1. Therefore, Applicants respectfully submit that claim 10 is patentable over *Perry*. Accordingly, the rejection is improper and must be withdrawn.

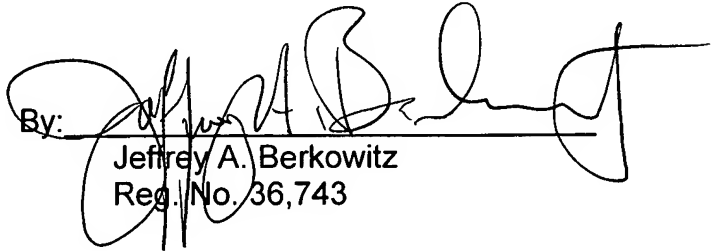
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 7, 2005

By: 
Jeffrey A. Berkowitz
Reg. No. 36,743

Attachments: New Abstract

 Information Disclosure Statement

 Four (4) Replacement Drawing Sheets for Figs. 1-3 and 11